

REMARKS

The Office communication mailed October 22, 2003 indicates that, on further consideration, further restriction under 35 U.S.C. § 121 is required. In particular, claims drawn to a method of manufacture of electrostatic speakers are designated as belonging in (new) Group I, and the product-by-process claims based on such method claims are designated as belonging in (new) Group II. Also in the Office communication mailed October 22, 2003, Group I is sub-divided, based on a subcombination/combination analysis, into Groups III and IV.

In Applicant's August 8, 2003 Response/election to the first restriction, Applicant argued that restriction was not appropriate in view of the discretionary nature of restriction, and the level of search required. The same arguments apply even more to the present further restrictions, especially to the division of Group I to Groups III and IV in the Office communication mailed 10/22/2003, and reconsideration on such basis is respectfully requested.

Further, in the present restriction, it appears there is a mis-conception that forms the foundation of the Group I/Group II restriction. It is believed that correction of this mis-conception provides the major basis for traversal of this restriction.

In particular, starting on line 3 of page 3 of the Office communication mailed 10/22/2003, it is stated, "In the instant case the product as claimed can be made by another and materially different process such that the electrostatic speaker does not require to be integrally constructed to the PCB." For reasons immediately following, this statement appears to reflect an inadvertently incomplete or inaccurate understanding of the nature of Applicant's invention.

While it may be true that electrostatic speakers in general are capable of being made by processes in which an electrostatic speaker, *in its entirety*, is not integrally constructed to a printed circuit board, any such electrostatic speaker likely is not relevant to the present

invention, and would not fall within the bounds of the product-by-process apparatus claims in newly defined Group II.¹ This is because in the present invention a portion of a printed circuit board (i.e., "PCB") *always* is a part of the electrostatic speaker. Thus, there is not a question of whether the electrostatic loudspeaker, ESL, is "integrally constructed to the PCB" (from the sentence starting on line 3 of page 3 of the Office communication mailed 10/22/2003, underline emphasis added). In distinct and significant contrast, in apparatus embodiments of the present invention, a portion of the PCB comprises (is part of) the ESL (underline emphases added). Therefore, the support for the justification of the restriction under MPEP 806.05(f) does not suit the actual composition and arrangement of elements that are relevant to the product claims which are restricted from their corresponding process claims. Based on this, Applicant's position is that the 10/22/2003 restriction of the invention into new Groups I and II is not proper.

Thus, accordingly, Applicant believes that the Patent Office has not fully satisfied the requirements for restriction as described in MPEP 806.05(f). Given the long delay from the September 29, 2003 filing date to the first Office communication in this case, given the second restriction in the Office communication mailed October 22, 2003, and given the above bases for traverse of the latter, it is Applicant's position that Groups I and II should be examined together based on equities weighing against further restriction and against a subsequent attempt by the Patent Office to justify the present restriction into Groups I and II. Applicant respectfully reminds the Patent Office that restriction is discretionary, and that, per MPEP 806.05, only if claims to invention(s) in the same application are distinct, *may* restriction be proper. Also, if they are not distinct, restriction is never proper. Here, the Patent Office has expended considerable time and effort toward substantial restriction, and, based on the above argument, has not convincingly supported the distinction between Groups I and II. It is Applicant's view that the time has come to move this case to examination on the merits.

¹ A possible exception: an ESL where the chargeable membrane is mounted onto a small section of PCB, which is then reversibly attached to a second PCB. But in this example the speaker itself, independent of the second PCB, is comprised of at least one PCB in communication with the chargeable membrane.

Thus, Applicant respectfully requests reconsideration and examination on the merits of all claims in Groups I and II.

As to the subcombination/combination restriction, regarding claims 27-29, in Group IV, Applicant believes that examination of these claims with Group III claims is not unduly burdensome. On review of the size of the respective subclasses using a commercial online database ("Delphion") on November 7, 2003, Group III's class 29, subclass 594 was shown to contain 218 patents. From that same database Group IV's class 29, subclass 609.01 was shown to contain 37 patents. The addition of 37 patents (and any other associated non-patent searching) cannot realistically be deemed to rise to an undue burden.

The same applies to claim 30, from Group II, which is drawn to an electrostatic speaker depending from claim 29 in Group IV – examination of this claim is not unduly burdensome.

However, if the examination of claims 27-30 would for any justifiable reason preclude traversal, Applicant respectfully requests that the Patent Office examine claims 1-26 on the merits.

Further with regard to the nature of the differences between the subject matter of Group III and Group IV claims, Applicant does not believe the combination/subcombination analysis is applicable in this instance, in part because a subcombination is best envisioned as a set of components or steps which can be conceptualized as a unit and applied in the assembly or process of a "combination" that is comprised of the subcomponent and additional components or steps. This combination/subcombination relationship simply does not apply here given the limitations of the claims in the two allegedly different groups. It is believed that the particular limitations in method claims 27-29 are amenable to incorporation into claims depending from claims in Group III, and Applicant reserves the right to add such dependent claims during prosecution of the present application.

Thus, Applicant believes the Group III and Group IV subdivision is incorrect and requests reconsideration of this restriction. Also, even if this restriction is deemed proper from a structural/logic standpoint, Applicant believes the examination of claims 27-29 will not be unduly burdensome given the small size of class 29/subclass 609.01. Reconsideration of this aspect of the restriction is respectfully requested.

Election/Restriction

In accordance with the 10/22/2003 restriction requirement, Applicant elects Group III, claims 1, 3, 5, 7, 9, 16, and 19-25, with traverse based on the above. Applicant cancels claims 2, 4, 6, 8, 17, 18, and 26-30 in order to comply with the 10/22/2003 restriction requirement.

Supplemental IDS

Applicant advises the Examiner that a Supplemental IDS was mailed on November 4, 2003.

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The Examiner is invited to call the undersigned if clarification is needed on any aspects of this Election, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion. Also, the Examiner is advised of an address change and it is requested that the address recently provided for Customer Number 29847 be used henceforth.

Respectfully submitted,


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